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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,098	02/05/2001	Robert Bernstein	4707-81342	1323
24628	7590	10/21/2005		
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			EXAMINER CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/777,098

Applicant(s)

BERNSTEIN, ROBERT

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/1/05</u> . | 6) <input type="checkbox"/> Other: _____  |

CC

**DETAILED ACTION**

1. This action is responsive to the paper(s) filed 8/2/05.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 line 12, there is no antecedent basis for the plurality of vendors.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-4, 7-12, 15-19, 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien et al (US6795809).**

Regarding claims 1-4, 7, 9-12, 15, 17-19, 21, O'Brien et al teaches systems, methods and apparatus for identifying customers at the POS and forwarding targeted promotional materials (coupons) to them if certain conditions are met. A database system [fig 1:20, 30] is provided which stores user information as well as desired user

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profiles [fig 1:22, 24, col 5:lines 52-58]. The user information is collected by the various POS systems and includes the user's previous purchase history [6:8-13] as well as information provided by the customer [4:10-13] in order to target offers by location [3:66-67, 6:18-20]. The system compares the collected information about identified users to the stored desired profiles in order to determine who will receive the targeted promotional offers. The selected offers are printed by a printer at the POS [abstract]. Looking to figure 1, the system portions 20 and 30 are taken to meet the broad "third party" language as at least element 20 is identified as a "Catalina" computer (invention is assigned to Catalina Marketing, an entity well known for providing Marketing systems for their clients) and host computer designed to run the system on behalf of the various stores. Any of the plural store location are taken to represent "independent vendors" as they are separate stores/locations. There are no specific regarding how the stored desired profiles are entered into the system, however it would have been obvious to one of ordinary skill at the time of the invention to have provided a vendor PC data entry device in order to enable a Catalina customer (i.e. a store) to define/enter a promotion and its targeting parameters into the system database) so that the targeted offers can be created and changed as store management dictated.

Regarding claims 8, 16, 22, O'Brien et al teaches that the offers can be targeted based upon a particular product (shampoo), brand names and product categories of the customer's previous purchases [6:23-29].

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**6. Claims 5, 6, 13, 14, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien et al in view of Hull et al (US2001/0042008).**

O'Brien et al does not teach providing an emailed promotional offer. Hull et al also teaches monitoring customer purchases at the POS and outputting targeted offers based upon various criteria. Hull et al teaches that the offers may be printed at the POS systems or they can be emailed to the customer [¶ 32]. It would have been obvious to one of ordinary skill at the time of the invention to have included email output of O'Brien et al's offers in order to provide a more convenient manner of collecting coupons. The customer need not have to hassle with bringing hard copy coupon home from the store upon each visit; they coupons can be conveniently collected on his home PC.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc